

### **REMARKS**

The Office Action of October 28, 2011 has been received and reviewed. This response, submitted along with a Petition for a One-Month Extension of Time, is directed to that action.

Claim 17 has been amended, and claim 22 has been cancelled. No new matter has been added.

The applicants would like to extend their thanks to Examiner Buckley and Primary Examiner Schnizer for their time and courtesies during a telephone interview with the applicant's attorney on February 9, 2012. While a formal agreement was not reached, the applicants believe that progress was made in clarifying the issues and moving the claims closer to allowance.

The applicants respectfully request reconsideration in view of the foregoing amendments and the following remarks.

#### **Claim Rejections- 35 U.S.C. §103**

The Examiner rejected claims 17, 20, 23, 24, 26, 30, and 31 under 35 U.S.C. §103(a) as obvious over Stora (US 6,403,109) in view of Manzo et al. (US 5,736,505) and Zastrow et al. (US 5,961,988); claims 18 as obvious over Stora in view of Zastrow and further in view of Gross et al. (US 5,637,318); claims 21 and 22 as obvious over Stora in view of Manzo and Zastrow and further in view of Gross et al. (US 5,643,601); claims 20 and 21 over Stora in view of Manzo and Zastrow, and further in view of Gross et al. (5,643,601); and claim 19 as obvious over Stora in view of Zastrow and Gross, and further in view of Pelle (US 5,811,083) and Nakanishi (US 6,576,623). The applicants respectfully traverse these rejections.

In view of the applicant's remarks and the data presented in a 132 Declaration, the Examiner has withdrawn the previous rejection of obviousness over a proposed five-fold dilution of Stora. However, the Examiner has changed the grounds of rejection such that the Examiner now asserts that it would have been obvious to a skilled artisan to dilute the concentration of the formulation of Stora with water by a factor of four, thereby achieving the presently claimed invention. The Examiner reasoned that it would be within the ordinary level of skill in the art to "optimize the base formulation presented...in order to optimize the formulation's efficiency and minimize cost and reasonably expect success from doing so". (Office Action, page 4, lines 9-12).

The applicants have amended present claim 17 by cancelling the limitation that the base can be oil or water. As amended, the invention relates solely to 5 to 25% by weight of a *water-only* base. In view of this amendment, the applicants respectfully submit that a *prima facie* case of obviousness cannot be established because a four-fold dilution of Stora, as proposed by the Examiner, results in a composition of over 80% water, which is well outside the presently claimed range.

Additionally, the applicants submit that the proposed dilution would render Stora unsuitable for its intended use as a "perfume composition". Indeed, if a proposed dilution renders the original prior art composition unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Stora is specifically directed to a "perfume or cologne" (Col. 1, line 13). In the field of perfumery, there are very specific terms defining the amount of perfume oil in a composition. For example, "Perfume" contains "Eau de Parfum" contains 10-20% essential oils, "Eau de Toilette" contains anywhere from 5-15% perfume oil, "Eau de

Cologne” contains 3-8% perfume oil, and aftershaves or “Splash” contain 1-3% perfume oils.<sup>1</sup> A four-fold dilution of Stora’s example 1 will result in a perfume oil concentration of approximately 2.38 wt.%, well below that of perfume or cologne. Rather, the dilution will result in a composition that would be considered in the perfume art as an aftershave or splash. Accordingly, the proposed dilution would render Stora unsuitable as a perfume or cologne.

Furthermore, the applicants also submit that the proposed dilution may also result in a translucent or opaque composition, which would also violate Stora’s intended use as a “transparent perfume composition”. In response to the previous rejection where the Examiner proposed a five-fold dilution, the applicants presented evidence showing that such dilution would alter the refractive index of the composition such that the diluted composition would no longer be transparent. Unfortunately, due to the inventor’s unexpected severe illness, the applicants could not perform similar experiments with a four-fold dilution, but have a reasonable belief that even a four-fold dilution would similarly result in a translucent or transparent composition. The addition of water through an aqueous dilution would substantially change the formulation’s refractive index. Indeed, Stora clearly and unequivocally stresses the importance of the refractive index of the emulsion, and the difference between the aqueous phase refractive index and the oil phase refractive index. In particular, the formulation has a refractive index of between 1.40 and 1.44, and a difference between oily phase and aqueous phase of 0.003 or less. (col. 2, lines 57-65; col. 4, lines 60-62) Since the refractive index of water is 1.33, a four-fold increase in water would substantially lower the resulting composition’s

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<sup>1</sup> The applicants include herewith the [www.wikipedia.com](http://www.wikipedia.com) reference page for “perfume”, which details the classification tables for the different perfume oil concentration ranges.

refractive index, and would further increase the difference between the refractive index of the two phases. Due to the change in refractive indices, the composition is unlikely to be transparent since the transparency of the composition is directly dependent upon the refractive index. (See col. 2, lines 57-65). Accordingly, Stora would therefore be rendered unsuitable for its intended use as a *transparent* perfume composition.

Further, there is nothing in Stora or in the knowledge of the skilled artisan to suggest that the proposed dilution would yield a predictable result. For example, by diluting the formulation and thereby increasing the water content to over 80 wt.%, there is a real question as to whether Stora's emulsion would remain stable, or whether the emulsion would form at all. In fact, the maximum amount of water permitted by Stora in the aqueous phase is 65 wt.% (col. 5, line 5), likely in order to ensure the stable emulsion. However, the proposed diluted formulation would have over 85 wt.% water in the aqueous phase, in clear contrast to Stora's maximum permissible amount. A skilled artisan could not reasonably predict whether a stable emulsion will form in the face of a drastic dilution. Additionally, it is unusual, to say the least, to suggest that an oily phase be diluted with water, as suggested by the Examiner. There are inherent uncertainties when diluting an oily phase with water with which the skilled artisan would have to contend.

Finally, during the interview, the Examiners questioned how the applicants arrived at the concentrations of the components of Stora's example 1 after dilution in what the applicant's have termed "normalization". The applicants would like to explain these calculations more clearly in hopes of putting to rest the questions about what is meant by "normalization" and how the calculations are made. In any mixture, the sum of

all the individual components of that mixture will total 100% of the whole composition. If a component is then added to the mixture in X amount, the resulting total will be 100% + X. For example, a mixture containing 100 parts is comprised of 50 parts Component A and 50 parts Component B. Component A comprises 50% of the mixture and Component B comprises the remaining 50%. Stated another way, the ratio of A:B is 50:50. If one were to add an additional 20 parts of Component B, the mixture now has 120 parts, but the total percentage of mixture is still 100%. The ratio of A:B is now 50:70, and Component A is now 41.7% (50/120) and Component B is 58.3% (70/120). This is a simplified example compared to the proposed dilution of Stora, but the basic premise is the same. In the Examiner's proposed four-fold dilution of water in Stora's Example 1, the amount of water is increased from 21.35 parts to 85.4 parts (21.35 parts \*4=85.4). However, while the parts of water increase, the total composition, as a *percentage*, remains at 100%. Because the amounts of the remaining ingredients such as perfuming base, Silicone DC, Perfluorodecaline, etc. remain the same, the *percentage* of these components as a total of the whole mixture must decrease. This is the basis for the applicant's normalization calculations. The applicants trust this issue is now clear, but invite the Examiner to contact the applicant's attorney should any questions remain.

Based on the foregoing remarks, the applicants respectfully submit that a *prima facie* case of obviousness cannot be established, and request that the Examiner withdraw the rejections.

The applicants believe the claims are now in condition for allowance, and such favorable action is respectfully requested. If any issues remain, the resolution of which can be advanced through a telephone conference, the Examiner is invited to contact the

applicant's attorney at the phone number listed below.

**PETITION FOR A ONE-MONTH EXTENSION OF TIME**

Applicants respectfully petition for a One-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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